

REMARKS

Claims 1 to 24 were pending in the application at the time of examination. Claims 1 to 12 and 19 to 24 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 2, 4, 5, 7, 8, 10 to 11, 13, 14, 16, 17, and 19 to 24 stand rejected as anticipated. Claims 3, 6, 9, 12, 15, and 18 stand rejected as obvious.

In the 35 U.S.C. § 112, second paragraph rejection of Claims 1, 7, 19, 21 and 23, the Examiner stated "there is no antecedent basis for 'said file navigation window.'" Applicants have amended Claims 1, 7, 19, 21 and 23 to consistently recite "said file navigation window." Applicants request reconsideration and withdrawal of the § 112, second paragraph rejection of Claims 1, 7, 19, 21 and 23 and the claims dependent thereon.

In the 35 U.S.C. § 112, second paragraph rejection of Claim 5, the Examiner cited "a latest used directories" as being unclear. Applicants amended Claim 5 to recite "a latest used directory." Similar amendments were made to Claims 11 and 17. Applicants request reconsideration and withdrawal of the § 112, second paragraph rejection of Claim 5.

In the 35 U.S.C. § 112, second paragraph rejection of Claims 6, 12 and 18, the Examiner stated "there is no antecedent basis for 'the list of user-defined directories.'" Applicants amended Claims 6, 12, and 18 to recite "the at least one user selected directory." Applicants request reconsideration and withdrawal of the § 112, second paragraph rejection of Claims 6, 12, and 18.

Applicants have incorporated the limitations of Claim 2 into Claim 1 and canceled Claim 2. Claims 4 to 6 were amended in view of the cancellation of Claim 2.

Applicants have incorporated the limitations of Claim 8 into Claim 7 and canceled Claim 8. Claims 9 to 12 were amended in view of the cancellation of Claim 8.

Applicants have incorporated the limitations of Claim 20 into Claim 19 and canceled Claim 20. Applicants have incorporated the limitations of Claim 22 into Claim 21 and canceled Claim 22. Applicants have incorporated the limitations of Claim 24 into Claim 23 and canceled Claim 24.

Claims 4, 10, and 16 are amended to correct an informality and to recite "a current document context."

Claims 5, 11, 17 are amended to correct an informality and to recite "a present computer or network session."

Claim 15 is amended to correct an informality and to recite "a document templates directory."

Claims 1, 7, 19, 21, and 23 stand rejected as anticipated by U.S. Patent No. 6,393,429, hereinafter Yagi. The Examiner cited Figures 9(A) and 9(B) of Yagi and stated in part:

However, it is understood that the ordinary **folder tree** is displayed regardless ... it is displayed by default. As shown in figure 9(B), the **folder tree** is a hierarchical list of all the folders and files on the user's computer. (Emphasis added.)

The MPEP requires:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e.,

identity of terminology is not required. *In re Bond*,
910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

MPEP §2131, 8th Edition, Rev. 1, p 2100-70 (Feb. 2003)

Yagi makes a distinction between a tree structure and a list and so teaches that a list is different from a tree structure. Nevertheless, the Examiner, without citation to any teaching in the prior art, stated that a folder tree structure is a hierarchical list. Even if this is correct, it teaches away from "a list" as used both in Applicants' disclosure and claims and in Yagi.

Moreover, Applicants submit that one of skill in the art, as evidenced by Yagi, makes a distinction between a tree structure and a list. Yagi stated "it is unnecessary to manipulate the folder tree a plurality of times until a folder containing the target file is located." Yagi, Col. 11, lines 18 to 20. Thus, Yagi teaches that in a list, it is possible to directly access a file, but in the folder tree a plurality of manipulations are required. This distinction must be considered when interpreting the claims in view of the level of skill in the art. Accordingly, Yagi fails to teach the "identical invention . . . in as complete detail as is contained in the Claim," as required by the MPEP. Applicants respectfully submit that the anticipation rejection is not well founded. Applicants request reconsideration and withdrawal of the anticipation rejection of Claims 1, 7, 19, 21, and 23 and the claims dependent thereon.

With respect to the anticipation rejection of Claim 13, the Examiner stated:

. . . this file selection screen includes a file navigation icon, specifically a Browse button. As further described above, Yagi teaches that upon a first action on this Browse button, the contents of a directory are displayed in the directory content window, i.e. list box . . . Yagi further teaches that upon a second action on the

Browse button, a file navigation dialog window, referred to as a folder tree screen is displayed.

Applicants note that the Examiner's statements are not supported by citation to Yagi. In fact, Yagi taught:

As shown in FIG. 9(A), a file selection screen 81 displayed when the item "Open" is selected in the file menu includes a "Browse" button 82, in addition to the "Location of file:" field showing a current folder and the list box showing a list of files contained in the folder.

When the "Browse" button 82 is pressed, the folder tree item creating section 28 is started. The folder tree item creating section 28 creates folder tree items in accordance with the display conditions set in the display item setting screen 44 of the setting screen 43, and the folder tree screen control section 29 displays a folder tree screen 83 as shown in FIG. 9(B). . . (Emphasis added.)

Yagi, Col. 10, line 61 to Col. 11, line 5. Hence, Yagi teaches that the Browse button is pressed. The other features cited by the Examiner are associated with the "Open" item in the file menu as quoted above. This fails to teach a file navigation icon that supports two different actions as recited in Claim 13.

Therefore, based upon the above quotation from the MPEP, Yagi fails to anticipate Claim 13. If the Examiner continues the rejection, the Examiner is respectfully requested to cite with specificity, the teachings in Yagi of two actions on the Browse button relied upon by the Examiner. Applicants request reconsideration and withdrawal of the anticipation rejection of Claim 13 and the claims dependent thereon.

Claims 3, 6, 9, 12, 15 and 18 stand rejected as being obvious in view of Yagi taken with U.S. Patent No. 6,370,549. Assuming that the combination of references is correct, the additional information relied upon by the Examiner from the secondary reference fails to overcome the basic deficiency of the Yagi as noted above with respect to the independent Claim.

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Accordingly, Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 3, 6, 9, 12, 15 and 18.

Claims 1, 3 to 7, 9 to 19, 21, and 23, remain in the application. Claims 1, 3 to 7, 9 to 12, 15 to 19, 21, and 23 have been amended. Claims 2, 8, 20, 22, and 24 were canceled.

For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 5, 2003.



Attorney for Applicant(s)

September 5, 2003
Date of Signature

Respectfully submitted,



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